REMARKS

Reconsideration of this application is respectfully requested.

The undersigned attorney thanks the Examiner for the telephone interview conducted on July 30, 2010, and particularly thanks the Examiner for his explanation that he would like to see the documents that are listed in the document that was included in the previously submitted declaration. In addition, the undersigned attorney thanks the Examiner for his indication that the Examiner will reconsider the rejection of the claims in light of the Bornstein reference, as further discussed below.

The Berger Reference

Claims 65, 68-73, 76-80, 83-85, 88-90, 93-95, 98, 99, 182, 184-247, 249, 250, 252-325 and 328-338 were rejected under 35 U.S.C. 102(e) as being anticipated by Berger et al. ("Berger") (US Patent No. 6,414,693). As discussed below, it is submitted that Berger is not valid prior art to the present application.

Berger issued on July 2, 2002 from an application filed October 12, 1999. The present application was filed on January 22, 2002, and thus Berger is not prior art under either 35 U.S.C. 102(a) or 102(b). Moreover, the present application is a continuation of U.S. Application No. 09/479,284, filed January 6, 2000 (now U.S. Patent 6,344,853) ("parent application"). Hence, there is, at the latest, a constructive reduction of practice of the claimed invention on January 6, 2000, which is slightly less than 3 months from the filing date of Berger.

Accompanying this amendment is a declaration under 37 C.F.R. §1.131, signed by the applicant of the present application, with attachments, that provides further documentary

support that the claimed invention was actually reduced to practice prior to October 12, 1999 or, in the alternative, that the claimed invention was conceived of prior to October 12, 1999 and with due diligence was developed until the filing on January 6, 2000 of the applicant's parent application. The previously submitted declaration, which contains copies of invoices showing legal efforts including preparing the parent application, from October 26, 1999 through January 6, 2000, is also referenced. It is noted that there is a period of time of less than three (3) months from the October 12, 1999 filing date of Berger to the filing of the parent application on January 6, 2000, of which patent counsel prepared the parent application for a significant portion of this period, and that the accompanying declaration sufficiently establishes conception prior to the filing date of Berger and diligence for the relevant period of time.

Hence, Berger is not prior art to the present application under 35 U.S.C. 102(e). Accordingly, it is requested that the rejection of the claims under 35 U.S.C. 102(e) in view of Berger be withdrawn.

The Bornstein Reference

Claims 65-99, 182-247, 249, 250 and 252-338 were rejected under 35 U.S.C. 102(e) as being anticipated by Bornstein (US Patent No. 6,144,388). The following discussion was discussed during the above-mentioned telephone interview with the Examiner and is presented to refresh the Examiner's memory in connection therewith.

First, each of the independent claims of the present application recite, in one form or another, that the "first image" is the decorative image that is either a logo image or a text image, and the "second image" is an image of a product.

Bornstein, however, lacks any discussion or suggestion that one of the images can be a logo image or text image. Rather, Bornstein describes the superimposing of an article of clothing, such as eyeglasses, t-shirts, etc., can be superimposed on an image of a person.

In the prior office action (referenced in office action under reply), the Examiner stated that Bornstein discloses "that the second image is a decorative image including any one of a group of images including logo image and a text image" and referred to Col. 14, line 39 "text objects" in Bornstein for support thereof. But this section in Bornstein pertains to the operation of storage and communication of data within a general purpose computer system (see col. 14, lines 15-30). Col. 14, lines 35-43 of Bornstein reads as follows:

> "As is well known in the art, primary storage 804 can be used as a general storage area and as scratch-pad memory, and can also be used to store input data and processed data. It can also store programming instructions and data, in the form of data objects, text objects, data constructs, databases, message stores, etc., in addition to other data and instructions for processes operating on CPU 802, and is used typically used for fast transfer of data and instructions in a bi-directional manner over the memory bus 808."

Clearly, this section of Bornstein has nothing to do with the type of image that is displayed or otherwise superimposed on another image.

Hence, Bornstein does not disclose, nor does it suggest, any of the systems, apparatuses and methods recited in the claims of the present application. Accordingly, it is requested that the rejection of the claims under 35 U.S.C. 102(e) as being anticipated by Bornstein be withdrawn.

In addition, various dependent claims recite features that also are not disclosed in Bornstein. For example, Bornstein does not disclose normalizing dimensions of images, such as recited in claims 188, 189, 257, 258 and 268. In the Office Action, the Examiner refers to col. 19, lines 46-58 of Bornstein for allegedly disclosing this feature. But this section in Bornstein doesn't disclose or suggest that each of the images be normalized. Rather, this section in Bornstein teaches that one image (e.g., the clothing image) be fitted or appropriately sized so that it "fits" onto the image of the person. In the present invention, normalizing pertains to resizing the dimensions of all of the "second" (e.g. logo) images to a similar dimension, as the term "normalized" is defined and understood in the art.

In addition, claims 241 and 242 recite the feature relating to identifying each logo alphabetically by the first letter of the name of the logo. Since Bornstein does not disclose images in the form of a logo or text, it clearly doesn't disclose or suggest this feature.

Still further, claims 255, 256 and 267 recite the placement hooks feature of the present invention, wherein the image of the product has a number of "placement hooks" corresponding to locations at which the logo or text image may be positioned. While Bornstein allows an image of clothing to be moved relative to the image of a person, no such placement hooks are described.

In view of the foregoing, reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

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